

Drawings

1. The drawings were received on 21 August 2009. These drawings are approved.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the curved surface of the weight contacting a “convexly curved” rim portions, as set forth in claims 24-25, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The amendment filed 4 January 2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: On page 6 of the specification, line 3 adds the description that integer n "is an even number and is at least 4". This is considered to be new matter, given the fact that the original specification only stated "n [2 illegible symbols] 6, 8".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 20 and 24-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 20 includes the limitation that n "is an even number and is at least 4". This limitation is not supported by the original specification, and is thus considered to be new matter.

Claims 24-25 include a limitation that the curved contact face of the weight contacts a "convexly curved rim portion". This limitation is not supported by the original drawings or specification.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 3-9, 11, 13-18, and 24-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 24-25 are indefinite due to the fact that it is unclear what is actually being claimed by the phrase "provided subsequently". It appears that this phrase may be drawn to a method limitation in an apparatus claim, which would receive no patentable weight (See MPEP 2113).

Claim 13 is indefinite due to the fact that it is unclear what is actually being claimed by the limitation of "hypothetical lines". It is unclear whether these elements actually exist in the invention.

Art Unit: 3617

8. Claim 24 recites the limitation "the obtuse-angled ends" in line 12. There is insufficient antecedent basis for this limitation in the claim. This limitation has not been previously set forth in the claims.

Claim Rejections - 35 USC § 102

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 24-25, 3-9, 11, 13-14, 16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Green et al. As best understood, Figure 4 of Green et al show a wheel balancing weight including a plurality of consecutive lateral sections that are connected with obtuse angle bends. The weight may be formed of steel. The lateral sections extend along different radii of curvature, with the central radius of curvature approaching infinity (i.e. being rectilinear). The lateral end sections have the smallest radii of curvature. Linear extensions of the lateral sections form acute angles with adjacent lateral sections. As best understood, the cross-section of at the bend portions is substantially equal to the cross-section of the lateral sections.

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 3617

12. Claims 15, 17, 20-21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al. Green et al does not specify that the clamping element is formed from spring steel. However, it is well known in the art that the securing clip (i.e. clamping element) of wheel weights is commonly formed from spring steel. Therefore, one of ordinary skill in the art at the time of the invention would have found it obvious to form the clamping element of Green et al from spring steel to provide predictable results.

Green et al also does not disclose the curvature of the lateral section corresponding to the progression of a parabola, hyperbola, or an ellipse. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the curvature of the weight in any of the above shapes, dependent upon the curvature of the element to which the weight will be attached, thus predictably allowing the curvature of the weight to match that of the element, thus increasing the aesthetic appearance of the weight.

Green et al further does not specify the method in which the curvature of the weight portions is determined. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to determine the curvature of the weight in any manner to allow the weight to correspond to the curvature of the element to which the weight is attached, thus increasing the aesthetic appearance of the weight. Furthermore, this would predictably reduce the effort required to install the weight on the element.

Response to Arguments

13. Applicant's arguments filed 4 January 2009 have been fully considered but they are not persuasive. The Applicant argues that Green et al lacks obtusely angled bends, and instead shows "substantially rectangular" bends. First, it is unclear what is actually being argued. Second, obtusely angled bends are not claimed (see below). Third, Green et al shows lateral sections of a weight having a curvature similar to that shown by the drawings of the instant invention.

The Applicant further argues that Green et al does not show the cross-sections at the bends being substantially equal to the cross-section at the lateral sections. However, the weight of Green et al shows a substantially constant cross-section over its length, which meets the limitations of the claims.

With respect to the Applicant's argument that Green et al solves a different purpose than the claimed invention, the weight of Green et al meets all of the limitations of the claims that set forth the physical structure of the weight. Green et al need not disclose every possible use for his weight. See *KSR International Co. v. Teleflex Inc.* 550 U.S. 398, 415 (2007).

14. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., obtusely angled bends) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are

Art Unit: 3617

not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON R. BELLINGER whose telephone number is (571)272-6680. The examiner can normally be reached on Mon - Thurs (9:00-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason R Bellinger/
Primary Examiner
Art Unit 3617